

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 5. This sheet replaces the original sheet 5 of 7. In Figure 5, previously omitted element 511, magnetic receptacle, has been added as per the request of the Examiner.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

REMARKS

The specification has been amended at page 33, line 3 to replace the obviously erroneous label "substrate 557" with the proper label "substrate 510." The substrate is properly labeled as "510" in the illustration of Figure 5 on page 7 at line 11 with many other proper references to the substrate as "510" throughout page 7. As such, the correction of the labeling of "substrate 510" on page 33, line 3 is not new matter.

The specification has likewise been amended at page 33, line 6 to replace the obviously erroneous "canted well 57" with the proper "canted well 557." Canted wells are properly illustrated as "557" on page 33 at line 3. Furthermore, canted wells are properly labeled as "557" in Figure 5 as originally filed. As such, the correction of the labeling of "canted well 557" on page 33, line 6, is not new matter.

Claims 197, 199 to 200 and 202 to 214 are pending in this application. Claims 198 and 201 are canceled. Claims 1 to 196 have been withdrawn in response to a Restriction Requirement. Claims 197, 203 and 208 have been amended. No new matter has been added by these claim amendments. Likewise no new search is required by these amendments. Applicants, therefore, respectfully request entry of the claim amendments made herein.

The amendment to claim 197 is supported by, for example, lines 2 to 8 on page 9 and lines 4 to 16 on page 16 of the specification as originally filed. These passages teach that it is the size of the magnetic receptacle that determines the number of target cells capable of immobilization and that size is defined by the magnetic strength of a localized magnetic field gradient.

The amendment to claim 203 is supported by, for example, lines 11 to 20 on page 7 of the specification as originally filed. The amendment to claim 208 is supported by, for example, line 7, page 7, to line 5, page 8 of the specification as originally filed with particular reference to lines 18 to 20 of page 7.

In Figure 5, previously omitted element 511, magnetic receptacle, has been added as per the request of the Examiner. Magnetic receptacles "511" are not new matter because magnetic receptacles are properly labeled in Figure 2(b) and Figure 4(b) as 211 and 411, respectively, and are properly illustrated on page 6, line 5, and page 7, line 1, respectively. As such, addition of element 511 to label "magnetic receptacles" is not new matter. Applicants respectfully request entry of the amendment to Figure 5.

OBJECTIONS TO SPECIFICATION

The Examiner objects to references on pages 31 and 32 to “magnetic receptacles 511” because Figure 5 does not contain a reference to “511.” Applicants submit herewith a corrected sheet containing Figure 5 where magnetic receptacles “511” has been added to the figure. This amendment should respond to the Examiner’s objection. As such, Applicants respectfully request the objection be withdrawn.

The Examiner additionally objects to page 33, line 3, because the disclosure references “substrate 557” and “canted walls 557.” Applicants have amended the paragraph beginning on page 33, line 3, to correct this obvious error replacing “substrate 557” with “substrate 510.” This amendment is not new matter because the substrate is properly illustrated as “510” in the illustration of Figure 5 found on page 7 at line 11 with many other proper references to substrate “510” throughout page 7. As such, the correction of the labeling of “substrate 510” on page 33, line 3 is not new matter.

REJECTION OF CLAIMS 197 TO 214 UNDER § 112, SECOND PARAGRAPH - DEFINITENESS

The Examiner has rejected claims 198 and 203-208 for indefiniteness and in particular has asserted deficiencies in claims 198, 203 and 208. To alleviate the Examiner’s concerns, claims 197, 203 and 208 have been amended in accordance with the Examiner’s instructions. Applicants herein respectfully present arguments in favor of the definiteness of the claims as amended and the remaining claims.

Claim 198 has been canceled, rendering its rejection moot.

The Examiner has rejected claim 203 and its dependent claims because claim 203 is unclear as to the structural relationship of the cell isolation device to the device of claim 197 and the structure of the device that functions to isolate cells when comprised by the device of claim 197. The Examiner further asserts that claim 203 provides no structure capable of cell isolation.

In response to the Examiner’s concerns, Applicants have amended claim 203 to expressly encompass the device of claim 197 along with a cell isolation device that shares periodicity with the magnetic receptacles of claim 197. The cell isolation device of claim 203 is capable of isolating the one to about five cells from other cells isolated and arrayed within the cell isolation device. The cell isolation device is either located within the array device of claim 197 or mated with the array device of claim 197.

Because Applicants have amended claim 203 in accordance with the Examiner's request to provide a structure capable of isolating cells and to clearly define the structural relationship between the array device of claim 197 and the cell isolation device defined in claim 203, Applicants respectfully request the Examiner withdraw the rejection of claim 203 and its dependent claims for lack of clarity.

The Examiner has also rejected claim 208 because claim 197 does not necessarily contain cells. Applicants have amended claim 208 such that the device of claim 197 expressly contains cells. As such, Applicants respectfully request the Examiner withdraw the rejection of claim 208.

REJECTION OF CLAIMS 197 TO 214 UNDER § 103 OBVIOUSNESS

The Examiner maintains the rejection of claims 197 to 214 over Ekenberg *et al.* (5,567,326) in view of Dolan *et al.* (6,136,182) and Liberti *et al.* (5,968,820). The Examiner rejects Applicants' earlier arguments in Applicants' response entered August 19, 2005 that the references fail to suggest the limitation of "about one to about five cells" immobilized in each of the magnetic receptacles. The Examiner has not accepted this argument because (1) "there is not structure required by the claims to limit the number of cells in each receptacle to only about one to five, and not more than five" and (2) "the claims do not require the about one to about five cells to be immobilized in each receptacle, but rather require the receptacles to be capable of immobilizing about one to five cells."

In response to the Examiner's rejection, Applicants have amended claim 197 to more clearly express the structure of the magnetic receptacles within the device of claim 197. The claim, as amended, provides that the magnetic field gradient is localized to immobilize one to about five cells in a discrete and predetermined location, *i.e.*, the magnetic receptacle. The structure of the device is not necessarily a physical structure. Rather, the localized magnetic field gradient provides the "structure" that provides the ability to immobilize only one to about five cells in a discrete and predetermined location.

Claim 197, as presently amended, clarifies a non-obvious distinction between the prior art and the presently claimed invention. The references cited by the Examiner in support of the obviousness rejection do not disclose or suggest a device where a magnetic field gradient is sufficiently localized to immobilize one to about five cells in a discrete and predetermined location. In fact, the references provide no teaching of a device that is capable of so limiting the number of cells in a "discrete location" that "further experimentation" may be facilitated.

The Examiner suggests the claims must require that cells be immobilized within the magnetic receptacles to overcome the prior art. Applicants respectfully traverse this suggestion. The prior art provides mere suggestions of devices capable of creating "dense congregations" of cells. *See, e.g.,* Liberti at col. 12, lines 2-4. The prior art does not teach or suggest a device capable of immobilizing one to about five cells associated with magnetic beads in a discrete and predetermined location. As such, Applicants respectfully submit the claimed device need not comprise immobilized cells to be patentably distinct from the prior art.

Because Applicants have amended the claims to respond to the Examiner's rejection, Applicants respectfully request the Examiner withdraw the rejection of claims 197 to 214 for obviousness.

CONCLUSION

Applicants submit that the foregoing amendments respond to the Examiner's objections and rejections and that the claims are in condition for allowance. As such, Applicants respectfully request the foregoing amendments be entered. Applicants authorize the Commissioner to charge any fee due or credit any overpayment arising from this communication to Kenyon & Kenyon's **Deposit Account No. 11-0600**.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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